

### **REMARKS**

Claims 1-11 are pending in this application. Claims 1 and 5 are independent claims. Claim 9 is amended, and no claims are canceled in the foregoing amendment. It is believed that this Amendment, in conjunction with the following remarks, places the application in immediate condition for allowance or at least presents the claims in better form for consideration on Appeal. Accordingly, entry of this Amendment and favorable consideration of the application are respectfully requested in view of the foregoing amendments and the following remarks.

### **Specification**

The abstract of the disclosure is objected to because the abstract uses an abbreviation not defined in the abstract itself. Applicants hereby submit an amended abstract that defines the abbreviation CDMA as “code division multiple access.” Therefore, Applicants respectfully request that the Examiner withdraw the objection.

### **Drawings**

The drawings stand objected to for allegedly failing to comply with 37 C.F.R. 1.83(a). Applicants disagree. Figs. 8a and 8b illustrate a system 800 and a system 850 which include “a signal level estimator 806,” “a signal level comparator 810,” “an accumulator 814,” “a new sector identification module 824,” and “an RPC filter 860” (see description in paragraphs [0067] – [0068]).

The Examiner quotes 37 C.F.R. 1.83(a) as requiring that “[t]he drawings much show every feature of the invention specified in the claims.” However, the full context of 37 C.F.R. 1.83(a) states:

The drawing in a nonprovisional application must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g., a labeled rectangular box). In addition, tables and sequence listings that are included in the

specification are, except for applications filed under 35 U.S.C. 371, not permitted to be included in the drawings. (37 C.F.R. 1.83(a)).

Furthermore, as pointed out in Applicants' own specification:

Those of skill would further appreciate that the various illustrative logical blocks, modules, circuits, and algorithm steps described in connection with the embodiments disclosed herein may be implemented as electronic hardware, computer software, or combinations of both. To clearly illustrate this interchangeability of hardware and software, various illustrative components, blocks, modules, circuits, and steps have been described above generally in terms of their functionality. Whether such functionality is implemented as hardware or software depends upon the particular application and design constraints imposed on the overall system. Skilled artisans may implement the described functionality in varying ways for each particular application, but such implementation decisions should not be interpreted as causing a departure from the scope of the present invention. (Applicants' Specification, paragraph [0070]).

Accordingly, Applicants submit that the requirements of 37 C.F.R. 1.83(a) have been met, and respectfully request that the Examiner withdraw this objection to the drawings.

### **Claim Objections**

**Claim 9 is objected to because of informalities. By this amendment, Applicants have** adopted the Examiner's suggestion and amended claim 9 to recite "said variable rate signal level" to correct a previous omission. Therefore, Applicants respectfully requests that the objection to claim 9 be withdrawn and the amendment entered.

### **Rejections under 35 U.S.C. §112**

Claims 1-4 stand rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement. As stated in MPEP § 2164.01, any analysis of whether a particular claim is supported by the disclosure in an application requires a determination of whether that disclosure, when filed, contained sufficient information regarding the subject matter of the claims as to enable one skilled in the pertinent art to make and use the claimed invention. The standard for determining whether the specification meets the enablement requirement was cast in the Supreme Court decision of *Mineral Separation v. Hyde*, 242 U.S. 261, 270 (1916) which

postured the question: is the experimentation needed to practice the invention undue or unreasonable? That standard is still the one to be applied.

Further, as stated in MPEP § 2164.01 (a), there are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is “undue.” These factors include, but are not limited to:

- (A) The breadth of the claims;
- (B) The nature of the invention;
- (C) The state of the prior art;
- (D) The level of one of ordinary skill;
- (E) The level of predictability in the art;
- (F) The amount of direction provided by the inventor;
- (G) The existence of working examples; and
- (H) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

This rejection is respectfully traversed in view of the foregoing factors. How a best serving sector is determined by the apparatus as claimed is clearly described in the specification with sufficient detail to enable one skilled in the art to make and use the apparatus as claimed, and thereby satisfies the enablement requirement of 35 USC § 112, first paragraph. If the Examiner attempts to maintain this rejection, Applicant respectfully requests that the Examiner specify what aspect / deficiencies in the disclosure would require one skilled in the art undue or unreasonable experimentation to practice the claimed invention.

Claims 1-11 stand rejected under 35 USC § 112, second paragraph, as being indefinite. This rejection is respectfully traversed. Applicants submit that the claims are presently worded are clear and satisfy all the requirements of 35 USC § 112, second paragraph. Therefore, Applicants respectfully request that the rejections of claims 1-11 under 35 U.S.C. §112 be withdrawn.

**Claim Rejections under 35 U.S.C. §102(e) – Ganesh**

Claims 1-3 and 5-8 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,360,098 to Ganesh et al. (hereinafter "Ganesh"). Applicants respectfully traverse this rejection, as detailed below.

**MPEP §2131 sets forth the standard for a 35 U.S.C. § 102 rejection:**

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *MPEP §2131 (quoting Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Id. (quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

In addition, “the reference must be enabling and describe the applicant’s invention sufficiently to have placed it in possession of a person of ordinary skill in the field of the invention.” *In re Paulsen*, 30 F.3d 1475, 1479, 31 USPQ2d 1671, 1673 (Fed. Cir. 1994).

The 35 U.S.C. § 102(e) anticipation rejection of claims 1-3 and 5-8 is improper because the rejection does not meet all of the above criteria for the reasons and explanations set forth below.

Ganesh is directed to a network planning tool for determining a ‘neighbor list’ to provide an “optimum” list of pilot channels for each sector in the network of candidate handoff channels for a given mobile station. (See col. 6, lines 55-62). A neighbor list is stored for each sector and determined by the network planning tool. To obtain a corresponding specific neighbor ‘set’ of pilot channels specific to a particular mobile station from the general neighbor ‘list’ stored by its current serving sector, the mobile station measures and reports the received strengths of the pilot channels on the neighbor list. In response, the associated sector servers send direction messages to the mobile station directing it to move a particular pilot channel to a particular one of the active, candidate, neighbor, and remaining sets maintained at the mobile station. (See col 6, lines 40-62).

The Examiner relies substantially on this description in columns 5 – 6 of Ganesh in rejecting the independent claims. However, in the cited section, Ganesh simply describes that a

mobile station measures pilot signal strengths for a list of pilot channels maintained by the mobile's current serving sector, that the mobile reports these measurements to the current serving sector, and that the serving sector instructs the mobile on which pilot channels should be moved into the mobile's neighbor set for handoff purposes. Accordingly, the Examiner appears to be reading in features of the claimed invention that are simply not described in the cited section of Ganesh.

For example, in the rejection of claim 5, the Examiner alleges that Ganesh discloses:

[A] comparator (**mobile station 32, col. 5, line 44**) comparing a plurality of signal levels (**signal strengths**) ("**the mobile station measures and reports to a sector server the [signal] strengths ...**", **col. 6, lines 43-44**) received from a plurality of active sectors with a signal level of a current serving sector (**a phase reference, col. 5, line 48**) to produce a difference (**comparison**) (**signal strength comparisons between base stations for determining when to hand off, col. 5, lines 49-50**). (Office Action, pgs. 7-8).

Initially, Applicants note that the mobile station is not disclosed in the cited section as itself comparing signal strengths, only measuring them and sending the measurements to a serving sector (which the Examiner specifically quotes here). Measuring and reporting do not necessarily include comparing. In addition, the Examiner appears to be equating the claimed "signal level of a current serving sector" with the phase reference described at col. 5, line 48. Here, Ganesh describes how the pilot channels are utilized by a mobile station to "acquire the timing of forward CDMA link 31, provide a phase reference for coherent demodulation, and provide a mechanism for making signal strength comparisons between base stations for determining when to hand off call traffic" (col. 5, lines 46-50). A phase reference for coherent demodulation simply coordinates received signals with a local oscillator to facilitate signal decoding, but has nothing to do with signal strength. Although Ganesh states that in, general, pilot channels provide a mechanism for making signal strength comparisons between base stations for determining when to hand off call traffic, the received signal measurements from other sectors are not specifically disclosed as being compared to a signal level of a current serving sector.

In the rejection of claim 5, the Examiner also alleges that Ganesh discloses:

[A] delta generator (**sector servers 28, col. 6, line 37**), coupled to the comparator, for generating a delta credit for each of said plurality of active sectors (**optimum list**) (**a neighbor list representing an "optimum" list for each sector, col. 6, line 54**) based on said difference... [and] an accumulator (**mobile station 32, col. 5, line 44**), coupled to the delta generator, for accumulating a plurality of delta credits to produce an accumulated total credit (**signal strengths are collected/accumulated before comparisons are made**) (**signal strength comparisons between base stations for determining when to hand off, col. 5, lines 49- 50**). (Office Action, pg. 8)

The Examiner thus appears to be equating the claimed delta credits generated for each of said plurality of active sectors with the signal strength measurements taken by the mobile for each pilot channel of the neighbor list (or “optimum” list). Initially, Applicants note that the mobile station takes the signal strength measurements, not the sector servers the Examiner has alleged anticipate the claimed delta generator. Furthermore, the signal strengths are simply measured by the mobile and are not delta credits based on a difference between signal levels as in the claimed invention.

The Examiner also appears to be equating the claimed “accumulating a plurality of delta credits to produce an accumulated total credit” with collecting signal measurements at the mobile station before comparisons are made. However, this contradicts the Examiner’s earlier assertion that the signal strength measurements (delta credits) are based on a difference between signal levels. How can signal strength measurements be based on a difference between them, yet be collected before any comparisons are made? Furthermore, even if the mobile of Ganesh does collect the signal strength measurements for multiple pilot channels before reporting them, of which the Examiner has not provided a showing, in this context it is not clear what the Examiner believes to anticipate the claimed “accumulated total credit.” Accumulating delta credits to produce an accumulated total credit is not the same as collecting signal measurements to form a list of signal measurements. The Examiner’s use of the term “collecting” is not equivalent to the claimed “accumulating” towards a total. Furthermore, the Examiner has used the same mobile

station here to anticipate the claimed accumulator as was used previously to anticipate the claimed comparator without providing a showing that the mobile station is capable of performing each function in concert.

For at least the above reasons, Applicants submit that Ganesh does not teach or suggest all the features recited in independent claim 5, and similarly recited in independent claim 1. Accordingly, Applicants submit that Ganesh fails to satisfy all the requirements of a proper 35 U.S.C. § 102(e) anticipation rejection.

### **Summary**

Since the Examiner has maintained his rejection of claims 1-3 and 5-8 under 35 U.S.C. § 102 and 103 as noted above, Applicant once again traverses these rejections. Applicant expressly maintains the reasons from the prior responses to clearly indicate on the record that Applicant has not conceded any of the previous positions relative to the maintained rejections. For brevity, Applicant expressly incorporates the prior arguments previously presented without a literal rendition of those arguments in this response.

For at least the foregoing reasons, it is respectfully submitted that claims 1 and 5 are distinguishable over the applied art. The remaining dependent claims are allowable at least by virtue of their dependency on the above-identified independent claims. See MPEP § 2143.01. Moreover, these claims recite additional subject matter, which is not suggested by the documents taken either alone or in combination.

Therefore, Applicants respectfully request that this rejection of claims 1-3 and 5-8 under 35 U.S.C. §102 be withdrawn.

## REQUEST FOR ALLOWANCE

In view of the foregoing, Applicants submit that all pending claims in the application are patentable. Accordingly, reconsideration and allowance of this application are earnestly solicited. Should any issues remain unresolved, the Examiner is encouraged to telephone the undersigned at the number provided below.

Deposit Account Authorization

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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